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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Allied Resident/Employee Screening Service, Inc.

Serial No. 76229388

Michael R. Clogan of Strasburger & Price, LLP for Allied
Resident/Employee Screening Service, Inc.

Susan Kastriner Lawrence, Trademark Examining Attorney, Law
Office 116 (Meryl L. Hershkowitz, Managing Attorney).

Before Seeherman, Walters and Chapman, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On March 22, 2001, Allied Resident/Employee Screening
Service, Inc. (a Texas corporation) filed an application to
register the mark RESIDENTCHECK on the Principal Register
for services then identified as "conducting background
investigations for others" in International Class 35. The
application is based on applicant's claimed date of first
use and first use in commerce of January 24, 2001.

The Examining Attorney required that applicant amend the identification of services due to indefiniteness thereof and classification in two classes; and refused registration on the ground that applicant's mark, RESIDENTCHECK, is merely descriptive of applicant's services under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1).

Applicant ultimately submitted identifications of services that read as follows: "conducting background investigation[s] for others of potential residents credit history" in International Class 36; and "conducting background investigations for others, namely, reviewing employment history and criminal background" in International Class 42, both of which were accepted by the Examining Attorney.¹

¹ Applicant's further proposed amendment to the International Class 36 services was not accepted by the Examining Attorney. Neither applicant nor the Examining Attorney treated this as an issue on appeal before the Board. The Board will determine this case based on the identifications of services set forth above.

In addition, applicant offered to divide out the International Class 36 services and seek registration of the mark on the Supplemental Register for those services. (Applicant's April 30, 2003 response, pp. 4-5.) The Examining Attorney explained, *inter alia*, in her July 17, 2003 Office action that the proper procedure (which includes a fee) for seeking a divisional application was not followed by applicant and therefore the request to divide (and thus seek registration of the mark for the International Class 36 services on the Supplemental Register) was denied. Applicant did not further pursue this matter. Thus, the only issue before the Board is whether the mark RESIDENTCHECK is merely descriptive of applicant's services as identified herein in International Classes 36 and 42.

When the refusal to register the mark as merely descriptive was made final, applicant appealed to this Board. Both applicant and the Examining Attorney have filed briefs; an oral hearing was not requested by applicant.

The test for determining whether a mark is merely descriptive is whether the term or phrase immediately conveys information concerning a significant quality, characteristic, function, ingredient, attribute or feature of the goods or services in connection with which it is used. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Eden Foods Inc.*, 24 USPQ2d 1757 (TTAB 1992); and *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract, but in relation to the goods or services for which registration is sought, the context in which the term or phrase is being used on or in connection with those goods or services, and the impact that it is likely to make on the average purchaser of such goods or services. See *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995); and *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991). Consequently, "[w]hether consumers could guess what the product [or service] is from consideration of the mark

alone is not the test." In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985). Rather, the question is whether someone who knows what the goods or services are will understand the term or phrase to convey information about them. See In re Home Builders Association of Greenville, 18 USPQ2d 1313 (TTAB 1990).

Applicant essentially contends that the mark must be looked at as a whole and not dissected into its parts, and when so analyzed the mark is suggestive; that imagination and thought are required to understand the meaning of the mark in relation to the services; that the terms "resident" and "check" each have multiple meanings (e.g., "resident" can refer to "not migratory" or "a physician serving a residency," and "check" can refer to "exposure of a chess king to an attack" or "a written order directing a bank to pay money as instructed"); that the USPTO has allowed registration of marks structurally similar to applicant's mark (e.g., CARCHECK, SHELF-CHECK, SCHOOLCHECK); that the mark clearly does not merely describe the International Class 42 services because those services do not specify that the background investigations are of potential residents; and that doubt is resolved in applicant's favor.

Essentially, the Examining Attorney's position is that applicant's mark, RESIDENTCHECK, consists of two

descriptive words; that neither the combination of the two words nor the order thereof creates a unique or incongruous mark; and that the mark merely describes the purpose of both of applicant's services -- its investigations of potential residents' credit histories and its investigations of employment histories and criminal background. The Examining Attorney correctly asserts that there is no requirement that a mark describe all attributes of a product or service in order to be merely descriptive thereof. See *In re Quik-Print Copy Shop, Inc.*, 616 F.2d 523, 205 USPQ 505 (CCPA 1980); *In re Richardson Ink Company*, 511 F.2d 559, 185 USPQ 46 (CCPA 1975); and *In re Analog Devices Inc.*, 6 USPQ2d 1808 (TTAB 1988), *aff'd* unpub'd but appearing at 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989). See also, 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §11:51 (4th ed. 2001).

The Examining Attorney has made of record the following definitions from The American Heritage Dictionary of the English Language (Third Edition 1992):

- (1) **resident** noun ...2. one who resides in a particular place permanently or for an extended period...; adjective 1. dwelling in a particular place; residing...; and

(2) **check** noun ...4. the act or an instance of inspecting or testing, as for accuracy or quality; examination... 5. a standard for inspecting or evaluating; a test...;

verb transitive ...5. to inspect so as to determine accuracy, quality, or other condition; test... 6. to verify by consulting a source or authority...;

verb intransitive ...3. to be verified or confirmed; pass inspection... 4. to make an examination or investigation; inquire....

The Examining Attorney also refers to (i) applicant's specimen of record (a printout of a page from its web site), and (ii) printouts of other pages from applicant's web site put into the record, one of which includes a "button" titled "Resident Screening," and all showing uses such as the following:

Welcome to ResidentCheck!
Allied's ResidentCheck service provides detailed credit and background information and online leasing recommendations. ...

Resident Screening
...When it comes to screening prospective residents, let Allied Resident Screening help you increase your NOI and manage your risk.

Applicant submitted a typed listing of 21 registered marks, all including the word "check," and asserted that none is under Section 2(f) of the Trademark Act, none is on

the Supplemental Register, and none includes a disclaimer of the term "check."² The Examining Attorney made of record numerous third-party registrations wherein the term "check" was disclaimed or the registrations were on the Supplemental Register.

Based on the record before us, we find that consumers will immediately understand the 'RESIDENTCHECK' mark to refer to a primary purpose of both of applicant's background investigation services, namely, investigating or checking the credit, employment and criminal backgrounds of persons who have applied to rent particular apartments or other types of dwellings.

We agree with the Examining Attorney that the combination of the words RESIDENT and CHECK into "RESIDENTCHECK" does not create a unique mark with a non-descriptive meaning. Rather, the term immediately describes the purpose of both services in connection with which applicant uses its mark. The term immediately

² Normally, typed listings are not sufficient to make third-party registrations of record. See *In re Duofold, Inc.*, 184 USPQ 638 (TTAB 1974). However, in the final Office action, the Examining Attorney did not explain that a typed list is insufficient to make registrations of record; instead, the Examining Attorney discussed the third-party registrations on the merits. Therefore, the Examining Attorney waived her objection (raised for the first time in her brief on appeal at footnotes 1 and 3) to applicant's submission of a typed list of third-party registrations. We have considered applicant's list of third-party registrations for whatever probative value it may have.

informs consumers that applicant's services (conducting investigations of potential resident's credit histories and conducting investigations of employment histories and criminal background) involve investigations of potential resident's credit and other background histories.

We are of the opinion that the term RESIDENTCHECK is no more than a combination of two merely descriptive terms, with the composite mark remaining merely descriptive. See *In re Omaha National Corporation*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987) (FIRSTIER (in stylized form) merely descriptive for banking services). The fact that the International Class 42 services are not limited to checking background of "potential residents" is not determinative. While applicant's identification for this international class of services is not limited to "potential residents," it does not exclude such persons as the subjects of the background investigations and, therefore, the identification encompasses employment and criminal background checks of potential residents. As such, the term immediately and without conjecture or speculation describes a significant purpose of the International Class 42 services as well as those in International Class 36.

Applicant's mark, RESIDENTCHECK, considered as a whole, when applied to applicant's services, is merely

descriptive of a significant purpose of the services (providing background checks of potential residents). See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) (APPLE PIE merely descriptive for potpourri); *In re Omaha National Corporation*, supra; *In re Cryomedical Sciences Inc.*, 32 USPQ2d 1377 (TTAB 1994) (SMARTPROBE merely descriptive of disposable cryosurgical probes); *In re Copytele Inc.*, 31 USPQ2d 1540 (TTAB 1994) (SCREEN FAX PHONE merely descriptive of facsimile terminals employing electrophoretic displays); and *In re Truckwriters Inc.*, 219 USPQ 1227 (TTAB 1983), *aff'd unpub'd Appeal No. 84-689* (Fed. Cir., November 1, 1984) (requirement for a disclaimer of the merely descriptive term "writers" for insurance agency services affirmed).

We find that the case cited by and most strongly argued by applicant is readily distinguishable from the facts herein. Particularly, the nature of that mark is significantly different from applicant's mark in that applicant's mark has a readily understood meaning. In the case of *In re TBG Inc.*, 229 USPQ 759 (TTAB 1986) the mark SHOWROOM ONLINE for "leasing computer databases and video disks in the field of interior furnishings and related products of others" was held not merely descriptive because

the mark "has no obvious meaning in relation to applicant's services."

With respect to the list of third-party registrations submitted by applicant, this evidence is not persuasive of a different result in this case. While uniform treatment under the Trademark Act is an administrative goal, the Board's task in an ex parte appeal is to determine, based on the record before us, whether applicant's mark is merely descriptive. As often noted by the Board, each case must be decided on its own merits. We are not privy to the records of the third-party registration files and, moreover, the determination of registrability of those particular marks by the Trademark Examining Attorneys cannot control our decision in the case now before us. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("Even if some prior registrations had some characteristics similar to [applicant's application], the PTO's allowance of such prior registrations does not bind the Board or this court.")

Decision: The refusal to register on the ground that the mark is merely descriptive under Section 2(e)(1) of the Trademark Act is affirmed as to both classes of services.